



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,160	04/28/2005	Masatoshi Kanayama	NIS-16015	4340

40854 7590 08/07/2007
RANKIN, HILL, PORTER & CLARK LLP
38210 Glenn Avenue
WILLOUGHBY, OH 44094-7808

EXAMINER

RECEK, JASON D

ART UNIT	PAPER NUMBER
----------	--------------

2109

MAIL DATE	DELIVERY MODE
-----------	---------------

08/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,160

Applicant(s)

KANAYAMA ET AL.

Examiner

Jason Recek

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02 May 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This is in response to application 10/529160 filed on April 28th 2005 in which claims 1-9 are presented for examination.

Status of Claims

Claims 1-9 are pending, of which claims 1-9 are in independent form.

Claims 7-9 are currently rejected under 35 U.S.C. 101.

Claims 1-9 are currently rejected under 35 U.S.C. 103(a).

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Art Unit: 2109

2. The abstract of the disclosure is objected to because it contains legal phraseology such as "means". Correction is required. See MPEP § 608.01(b).

Claim Interpretation

3. Regarding claims 1-3, the words "means for" is an attempt to use "means" clause to recite a claim element as a means for performing a specified function. However, since no limitations or details are described by the specification (the specification merely recites the use of "means" pg. 12-20) the claims will be given their broadest reasonable interpretation. The claims will not be interpreted as means plus function claims in accordance with *In re Donaldson*.

4. Regarding claims 4-6, the words "function for" lack support in the specification and thus will not be treated as means plus function claims, see above.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 7-9 are directed to and recite, "a program".

Programs and computer software are not statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanai et al. US 2006/0085282 A1.

Regarding claim 1, Hanai discloses "a plurality of user terminal devices each having an operation section and a display section and connected to a communication network" as terminals connectable to communication networks (pg. 3 paragraph 59, Fig. 1), "a host computer connected to said communication network for communicating with said plurality of user terminal devices and obtaining user information from said user terminal devices" as a server (pg. 3 paragraph 58, Fig. 1), "combined equipment selection system receiving service equipment information on a service equipment which a user wishes to use" as a user entering information about the equipment (pg. 1 paragraph 10), "selecting one or more other combined equipment which is different from said service equipment and is suitable for being combined with said service equipment based on said service equipment information" as selecting equipment that is suitable for use based on the user entered information about the equipment (pg. 1 paragraph 13), "displaying said selection information on said combined equipment onto said display" as displaying the equipment to the user (pg. 1 paragraph 15, Fig. 10), "user terminal

Art Unit: 2109

devices includes: a user information memory means for storing said user information" as a database for storing user information (pg. 3 paragraph 59, 61-63 Fig. 2), "a constant data memory means for storing constant data on said service equipment" as a database for retrieving information about the equipment (pg. 3 paragraph 59, 61-63, Fig. 2). Hanai further discloses, "a selection information display control means for requesting a display permission from said host computer for displaying said selection information [...] and displaying said selection information onto said display section only when said display permission is obtained from said host computer" as a log-in where a user must be authenticated before information is displayed, if authentication fails, the user is directed to register (pg. 8 paragraphs 114-17), and "wherein said host computer includes an information memory means for storing said user information and said selection information obtained from said user terminal device" as a database connected to the server which stores user information (pg. 5 paragraph 73-74, Fig. 4), and "transmission means for transmitting said display permission" as a communication controller capable of transmitting on the communication network (pg. 5 paragraph 73).

Hanai does not specifically disclose, "a combined equipment selection means for carrying out a selection operation which selects one or more other combined equipment which is different from said service equipment and is suitable for being combined with said service equipment, based on model information and operational conditions of said service equipment entered from said operations section, and said constant data stored in said constant data memory means" included on the user terminal, however Hanai

Art Unit: 2109

does disclose a system that recommends items which are different from the selected item or item already in possession and such recommended item is based on user information and item information (pg. 1 paragraph 13, pg. 5 paragraph 70-1) however in the pictured embodiment (Fig. 1, 4) the selection system resides in the server and not in the user terminal. Hanai teaches that the selection system may be included in the user terminal by recording the program onto a medium and distributing it (pg. 10 paragraph 133). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to have the selection system contained on the user terminal as suggested by Hanai.

Regarding claim 2, it contains many of the same limitations as claim 1 which are discussed above and will not be repeated here. Hanai does not specifically disclose "[user terminal device including:] a variable data memory means for storing variable data [...] transmitted from said host computer" however Hanai teaches a database connected to the server which holds updated items (pg. 6 paragraph 83) these updated items would be necessary for proper selection. Although Hanai does not specifically disclose that the database holding the updated (variable) items is included at the user terminal, Hanai teaches that the DBs may be combined (pg. 10 paragraph 129). Following the suggestion from Hanai it would have been obvious to one of ordinary skill in the art at the time of the invention to include a database at the user terminal that held variable data for the purpose of receiving information from the host.

Hanai also discloses "selection means for carrying out a selection operation [...] based on [...] variable data stored in said variable data memory means" as generating related item information from the updated content of the database (pg. 6 paragraph 83), "confirming whether or not said variable data are updated when said display permission is obtained from said host computer" as checking the database when the user is authenticated (pg. 6 paragraph 93-4, pg. 8 paragraph 115, Fig. 20).

Regarding claim 3, it contains many of the same limitations as claims 1 and 2 which are discussed above and will not be repeated here. Hanai discloses "an update means for receiving said variable data from said host computer on condition that said user information is transmitted to said host computer, and updating said variable data stored in said variable data memory means" the variable data memory means is a database which is updated with new information (pg. 6 paragraph 83), and such data is sent to the user after sending user information (pg. 8 paragraph 115), and "transmitting updated said variable data to said user terminal" as transmitting information to the user (pg. 8 paragraph 115).

Regarding claims 4-6, they are substantially similar to claims 1-3 respectively and therefore are rejected for the same reasons.

Regarding claims 7-9, they are software claims that correspond to the systems of claims 1-3 respectively, Hanai discloses the systems of claims 1-3 in a computer

Art Unit: 2109

network environment and thus inherently discloses that the systems are performed on a computer.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Duffy et al. US 2003/0212610 A1 discloses a system for managing transactions.

Weisman et al. US 2003/0014329 A1 discloses a system for managing replacement parts.

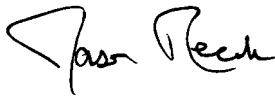
Gupta et al. U.S. Pat. 5,825,651 discloses a system for selecting items.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Recek whose telephone number is (571) 270-1975. The examiner can normally be reached on Mon - Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Coby can be reached on (571) 272-4017. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2109

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Recek
7/30/07



TIANZ COBY
SUPERVISORY PATENT EXAMINER